



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

BURNES DOANE SWECKER & MATHIS, LLP
P.O. BOX 1404
Alexandria, VA 22313-1404

(For Patent Owner)

Sadao Kinashi
WESTERMAN HATTORI DANIELS & ADRIAN, LLP
1250 Connecticut Avenue, N.W.
Suite 700
Washington, DC 20036

(For Requester #1)

John E. Wagner
Law Offices of John E. Wagner
3541 Ocean View Boulevard
Glendale, CA 91208

(For Requester #2)

In re reissue application of
Degner et al.
Application No. 10/734,073 ✓
Filed: December 12, 2003
For: U.S. Patent No. 5,074,456

In re Degner et al.
Reexamination Proceeding
Control No. 90/007,027
Filed: May 4, 2004
For: U.S. Patent No. 5,074,456

In re Degner et al.
Reexamination Proceeding
Control No. 90/007,114
Filed: July 8, 2004
For: U.S. Patent No. 5,074,456

MAILED

APR 07 2005

REEXAM UNIT

DECISION
MERGING
REEXAMINATION
AND REISSUE
PROCEEDINGS

The above-identified reissue application and reexamination proceedings are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,074,456 issued to Degner et al., on December 24, 1991.
2. Patent owner filed a reissue application based on the '456 patent, on December 12, 2003, which was assigned Application No. 10/734,073. In a preliminary amendment filed with the reissue application, claims 18 and 33 were amended.
3. Notice of the filing of the '073 reissue application was published in the *Official Gazette* on March 9, 2004.
4. Reexamination of the '456 patent was requested by a third party requester on May 4, 2004, and the resulting reexamination proceeding was assigned Control No. 90/007,027.
5. Reexamination of the '456 patent was requested by another third party requester on July 8, 2004, and the resulting reexamination proceeding was assigned Control No. 90/007,114.
6. Reexamination was ordered in the '7027 proceeding on July 23, 2004.
7. On August 23, 2004, a paper waiving the right to file a patent owner's statement under 37 C.F.R. 1.530, was filed in the '7027 proceeding.
8. Also on August 23, 2004, a Notification of Concurrent Proceedings under 37 C.F.R. 1.565(a) and Request for Consolidation under 37 C.F.R. 1.565(c), was filed in the '7114 proceeding, and in the '073 reissue application.
9. Reexamination was ordered in the '7114 proceeding on September 21, 2004.

DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 1.565(d) :

(d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the two reexamination proceedings are currently pending. Since the Orders have been mailed pursuant to § 1.525 in both the '7027 and '7114 reexamination proceedings, a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of all of the proceedings. In making a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the prosecution history of the '7027 and '7114 reexamination proceedings shows that original patent claims 1-36 are pending in each reexamination proceeding.

A review of the reissue (Application No. 10/734,073) prosecution history shows that the reissue application was published in the *Official Gazette* on March 9, 2004. In the reissue application, patent owner has amended claims 18 and 33. Therefore, the claims are **not** identical in all three proceedings.

In order to provide efficient and prompt handling of all three proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the two reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and both

of the reexamination proceedings will be conducted in accordance with the decision set forth below.

**DECISION MERGING THE REISSUE AND
REEXAMINATION PROCEEDINGS**

I. Merger of Proceedings

The above-identified reissue and two reexamination proceedings are merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in All Three Proceedings

The patent owner is required to maintain identical amendments in the reissue application and both of the reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in all three files is required as long as the proceedings remain merged. See 37 C.F.R. § 1.565(d). As noted above with regard to the amendments submitted, the claims are NOT the same in all three files. **An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in all three cases, specifically, Application No. 10/734,073, and Control Nos. 90/007,027 and 90/007,114.** The response to the requirement must be limited to placing the same amendments in all three cases, and patent owner must **not** address the issues of any of the proceedings in the housekeeping amendment. The housekeeping amendment should be submitted as a single paper, including the identifying data for all three files (i.e., the reissue Application No. and the two reexamination proceeding Control Nos.) and a signature, and should be filed in triplicate for entry into each of the reissue and two reexamination files.

It should be noted that the housekeeping amendment for the merged proceeding should be provided in the proper format for reissue applications. **Amendments in a reissue application must be in compliance with 37 C.F.R. § 1.173,** therefore all amended claims should contain bracketing and underlining with regard to the original patent text pursuant to 37 C.F.R. § 1.173(b)(2), (d) and (g) and all new claims must be completely underlined pursuant to

37 C.F.R. § 1.173(b)(2) and (d)(2). Please be aware that a "clean copy" of the amendment is not required by this rule. Note that amendment practice pursuant to 37 C.F.R. § 1.121 does not apply to reissue applications, as specifically indicated in 37 C.F.R. § 1.121(a) and (i), and therefore "Revised Amendment Practice" does not apply to reissue applications. Therefore, the required housekeeping amendment must be in compliance with 37 C.F.R. § 1.173, e.g., all amended claims should contain bracketing and underlining with regard to the original patent text pursuant to 37 C.F.R. § 1.173(b)(2), (d) and (g).

III. Conduct of the Merged Reissue and Reexamination Proceedings

Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding.

Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the two reexamination proceedings. Each action will contain identifying data *for all three of the cases, i.e.*, the reissue application and both of the reexamination proceedings. Each action will be entered into all three files (which will be maintained as separate files).

Any response by the applicant/patent owner must consist of a single response, with **three copies being filed** for entry in all three files, with each of the three copies bearing a signature, and containing identifying data for all three of the cases (*i.e.*, the reissue Application No. and both of the reexamination proceeding Control Nos.).

If the reissue application ultimately matures into a reissue patent, the reexamination proceedings shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 C.F.R. § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved as to the

will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved as to the reissue application. With respect to the two merged reexamination proceedings, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed in the merged reexamination proceedings as a result of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding as to the reissue application, and continue examination as to the two merged reexamination proceedings. Any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner upon dissolution of the reissue application from the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution of the reissue application from the merged proceeding would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).

If applicant/patent owner files a Request for Continued Examination (RCE) of the reissue application under 37 C.F.R. § 1.114, the reissue application is not considered to be expressly abandoned; rather the finality of the Office action is withdrawn, and the merged proceeding will continue. This is so, because an RCE is not an abandonment of any application, whether it be a reissue application or a non-reissue application.

CONCLUSION

1. The above-identified reissue application and two reexamination proceedings **ARE MERGED** into a single consolidated proceeding.
2. The reissue application file and the two reexamination files are being forwarded to the Group Director of Technology

- Center 1700. All further examination should be conducted in accordance with this decision.
3. Pursuant to Part II of this decision, a housekeeping amendment is required **within ONE (1) MONTH of this decision**, placing the same amendments in all three cases of the present merged proceeding, which amendment must be in compliance with 37 C.F.R. § 1.173.
 4. The examiner should issue an Office action for the present merged proceeding of the reissue application and the two reexamination proceedings **after** the earlier of the following events have occurred:
 - (a) the submission of the housekeeping amendment to place the same amendments in all three cases; or
 - (b) the expiration of the ONE (1) month period from the mailing of this decision for filing the amendment.
 5. It should be noted that failure to submit an appropriate "housekeeping amendment" **within one month of this decision** placing the same amendments in all three files will result in the Office's rejection of any claim that does not contain identical text in all three merged proceedings under 35 U.S.C. § 112, second paragraph, as being indefinite as to the content of the claim, and therefore failing to particularly point out the invention.
 6. All further examination should be conducted in accordance with Parts II and III of this decision.
 7. Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7722.



Lynn M. Kryza
Senior Patent Special Projects Advisor
Office of Patent Legal Administration

April 5, 2005